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Atty. Dkt. No. 065691-0199

1626

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Loret et al.  
Title: ANTI-RETROVIRAL FUNCTIONALISED AROMATIC COMPOUNDS  
Appl. No.: 09/622,645  
Filing Date: September 8, 2000  
Examiner: K.A. Saeed  
Art Unit: 1626

AMENDMENT TRANSMITTAL

Mail Stop NON-FEE AMENDMENT  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith is an amendment in the above-identified application.

[X] Amendment and Reply Under 37 C.F.R. §1.111 (3 pages).

[X] The fee required for additional claims is calculated below:

	Claims as Amended	Previously Paid For		Extra Claims Present	Rate		Additional Claims Fee
Total Claims:	65	76	=	0	x	\$18.00	= \$0.00
Independents:	7	7	=	0	x	\$84.00	= \$0.00
First presentation of any Multiple Dependent Claims:					+	\$280.00	= \$0.00
CLAIMS FEE TOTAL:							= \$0.00

[X] The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

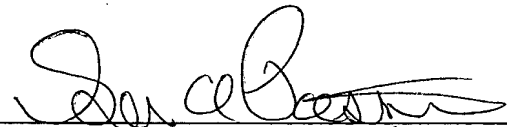
Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date

6/11/13

By

 for  
(45,943)

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Application No. 09/622,645

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Examiner: K.A. Saeed

Art Unit: 1626

**AMENDMENT AND REPLY UNDER 37 C.F.R. § 1.111**

Mail Stop NON-FEE AMENDMENT  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This communication is responsive to the Non-Final Office Action dated March 11, 2003, concerning the above-referenced patent application. It is timely, because it is filed within the shortened statutory period set to expire June 11, 2003.

**REMARKS**

**Status of the claims**

Claims 71, 74-85, 87-138 are pending, claims 101-116 are elected, and claims 71, 74-85, 87-100, and 117-138 are withdrawn. The withdrawn claims should be rejoined and examined.

**Rejections under 35 U.S.C. § 103**

Claims 101-113 are rejected under 35 U.S.C. § 103 (a) as allegedly unpatentable over Steemers *et al.*, *Journal of American Chemical Society* 117(37)9408-14 (1995). Applicants respectfully traverse the rejection.

The PTO admits that the compounds of Steemers differ from the claimed compounds but also proposes to add a methyl group to replace a H-atom on Steemers' compound, because "alkyl and H are art recognized equivalents." *See* Office Action of March 11, 2003, p. 4. Moreover, the PTO alleges that structurally similar compounds are generally expected to have similar biological and chemical properties. *See* Office Action, page 4.

Every case of prima facie obviousness depends upon an involved factual inquiry. MPEP § 2141. By citing both *Wood* and *Lohr*, however, the PTO improperly generalizes findings of fact specific cases to all teachings, including those of Steemers. This approach directly conflicts the position stated in MPEP § 2144.09: Analogs are not necessarily considered equivalent by one of ordinary skill in the art. In other words, the PTO has the initial burden to identify evidence showing and to explain why "alkyl and H are art recognized equivalents" in the contexts of Steemers' teachings. Yet the evidence and explanation of record are silent on this issue.

Furthermore, the PTO has the initial burden to establish that both the claimed compounds and the cited compounds are expected to share a similar utility. MPEP § 2144.09. But Steemers fails to teach a practical utility. In fact, Steemers is concerned with confirming a triplet energy transfer hypothesis (p. 9409, col. 2). Steemers even admits practical applications are not provided by its teachings (p. 9412, col. 1). Thus, the evidence and explanation of record do not show that Steemers' compounds have any utility. Thus, the rejection is improper and should be withdrawn.

### **Claim Objections**

Claims 114-116 are objected to as being dependant upon a rejected base claim but would be allowable if rewritten in independent form. *See* Office Action, page 4. Applicants thank the PTO for indicating allowable subject matter.

### **CONCLUSION**

As all of the rejections presented by the Examiner have been addressed, withdrawal of the rejections and allowance of the claims are respectfully requested.

If there are any questions concerning this application, the Examiner is courteously invited to contact the undersigned counsel.

Respectfully submitted,

Date

6/11/3

By

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.